

inserting the surgical instrument of the surgical assembly into an anatomy of a person until the end effector member reaches an internal surgical site within the anatomy of the person;

pivoting manually a wrist-pivoting element of the control assembly to cause the wrist member of pivot correspondingly about the distal forearm end and along the first axis; and

moving manually an end effector-controlling element of the control assembly to cause the end effector member to move about the second axis and perform a surgical procedure at the internal surgical site within the anatomy of the person.

105. A minimally invasive surgical method comprising the acts of:

(a) providing a surgical instrument comprising a forearm member, a wrist member pivotally connected to the forearm member, and a surgical end effector member movably coupled to the wrist member;

(b) inserting the surgical instrument into an anatomy of a person until the surgical end effector member reaches an internal surgical site within the anatomy of the person;

(c) displaying an image of the surgical end effector at the internal surgical site for viewing by an eye of an operator at a control station; and

(d) moving manually by the operator a surgical control handle of the control station to cause the surgical end effector to move and perform a surgical procedure at the internal surgical site within the anatomy of the person.

REMARKS

Claims 46-76, 78, 79, 81, 82, 84-86, 90-95, 97-99, 101, and 103 were rejected by the Examiner under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 46-57, 69, 71, 72, 77-84, 87-92, 96, and 97 were rejected under 35 U.S.C.

§102(e) as allegedly being anticipated by U.S. Patent No. 5,217,003 to Wilk (hereinafter "Wilk"). Claims 58-68, 70, 85, 86, 93-95, 98, and 99 were rejected by the Examiner under 35 U.S.C. §103(a) as allegedly being unpatentable over Wilk as applied to claims 46-57, 69, 71, 72, 77-84, 87-92, 96, and 97, and further in view of "Another Pair of Hands for Surgeon?" from the *Perspective* magazine of record (hereinafter "Perspective"). Claims 73, 75, 100, and 102 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Wilk as applied to claims 46-57, 69, 71, 72, 77-84, 87-92, 96 and 97, and further in view of "Telesurgery May Bridge Future Gaps" by Richter of record (hereinafter "Richter"). Applicant has amended claims 46, 64, 65, 78, 85 and 86 to obviate the 35 U.S.C. §112 rejection. Applicant has added independent Claims 104 and 105 to further patentably define the invention. No further amendments to any of the currently pending claims are necessary, as all claims currently pending stand patentable over Wilk, either taken alone or in combination with Perspective and/or Richter.

As indicated, independent claims 46 and 77 stand rejected under 35 U.S.C. §102(e) to Wilk. As the Court of Appeals for the Federal Circuit (CAFC) stated in *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 750, 218 USPQ 781 (Fed. Cir, 1983): "'Anticipation focuses on whether a claim reads on the product or process a prior art reference discloses, not on what the reference broadly 'teaches'." Also, as the CAFC held *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566(Fed. Cir. 1990): "'For a prior art reference to anticipate in terms of 35 U.S.C. §102, every element of the claimed invention must be identically shown in a single reference.' ... These elements must be arranged as in the claim under review,...."

The undersigned attorney respectfully submits that Wilk does not anticipate the claimed methods of independent claims 46 77, 104, and 105 particularly because every element and/or process step or act of independent claims 46, 77, 104 and 105 is not identically shown in Wilk, as demanded by *In re Bond*, supra. Wilk teaches a forceps instrument 20 passing through a tube or cannula 24. Attached to the end of the forceps instrument 20 is

a pair of forceps jaws 21. Cannula 24 is capable of being pivoted at its point of penetration through abdominal wall about two axes by a rotary drive 24. Obviously, the forceps instrument 20 will correspondingly move with the cannula 24. Wilk also teaches a translatory drive 26 for sliding forceps instrument 20 longitudinally through the cannula 24.

Wilk does not teach or suggest *inter alia* a surgical instrument comprising a forearm member (e.g., control arm 150L in Fig. 10 by way of example only and not by way of any limitation), a wrist member (e.g., wrist 172 in Fig. 11 by way of example only and not by way of any limitation) pivotally connected to a distal forearm end of the forearm member, and an end effector member (e.g., gripper 170 in Fig. 11 by way of example only and not by way of any limitation) movably coupled to the wrist member. Wilk does not teach or disclose a wrist member, only a forceps instrument 20 slidably passing through the cannula 24 and having a pair of forceps jaws 21 secured at an end thereof. More specifically, Wilk does not teach or disclose a wrist member pivotally secured (as claimed) to the forceps instrument.

Wilk also does not teach or suggest *inter alia* pivoting manually a wrist-pivoting element of the control assembly to cause the wrist member to pivot correspondingly about the distal forearm end of the forearm member. The input device 50 in Wilk is taught as having a joy stick 60 for controlling the operation of the 2-axis rotary device 24 which pivots the cannula 14 in two possible directions, a knob 62 for controlling the rotation of the forceps instruments 20 by the rotary drive 28, a slide switch for controlling translatory movement of the forceps instruments 20 by the translatory drive 26, and another slide switch 66 for controlling actuation of the forceps jaws 21 by the instrument activator 30 (see column 3, lines 30-35). None of the foregoing control instruments cause a wrist to pivot about the distal end of the forceps instruments 20.

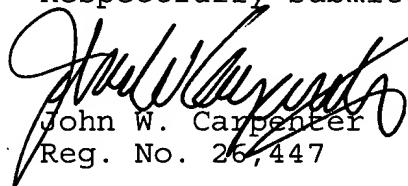
Thus, independent claims 46, 77, 104 and 105 are not anticipated by Wilk under 35 U.S.C. §102(e), and are patentably distinguishable over Wilk, either taken singly or consequentially in combination with Perspective and/or Richter. Therefore,

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independent claims 46 and 77, 104 and 105 and all claims depending therefrom are now in condition for allowance, and an early notice of same is respectfully solicited.

Respectfully submitted,



John W. Carpenter  
Reg. No. 26,447

TOWNSEND and TOWNSEND and CREW LLP  
Two Embarcadero Center, 8th Floor  
San Francisco, California 94111-3834  
(415) 576-0200  
Fax (415) 576-0300

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